



Docket No.: 239478US2

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 10/603,772

Applicants: Akio UENISHI

Filing Date: June 26, 2003

For: SEMICONDUCTOR DEVICE SERVING AS A
PROTECTING ELEMENT

Group Art Unit: 2815

Examiner: WILSON, A. R.

SIR:

Attached hereto for filing are the following papers:

Response to Election of Species Requirement

Our check in the amount of **\$0.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

RE APPLICATION OF

AKIO UENISHI

: EXAMINER: WILSON, A. R.

SERIAL NO: 10/603,772

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RESPONSE TO ELECTION OF SPECIES REQUIREMENT

COMMISSIONER FOR PATENTS
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SIR:

In response to the Election Requirement dated February 18, 2004, Applicant elects with traverse Species II, and identifies Claims 3-13 as readable thereon. Specifically, the subject matter recited in Claims 3-13 corresponds to Figures 9-16.

Applicant respectfully traverses the Election Requirement for several reasons.

First, the outstanding Official Action fails to state any basis whatsoever in support of the Election Requirement. This violates MPEP § 816, which states:

The particular reasons relied on by the Examiner for holding the invention as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given....

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has not carried forward its burden of proof to establish distinctness.

Secondly, MPEP § 806.04(f) requires:

Claims to be restricted to different species must be mutually exclusive....

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics, and this failure provides a further basis for traversing the Election Requirement.

Finally, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of Species I and II appear to be part of an overlapping search area.

Therefore, Applicant traverses the outstanding Election Requirement on the grounds that a search and examination of the entire application would not place a serious burden on the Examiner.

Accordingly, it is respectfully requested that the requirement to elect a single species be withdrawn, and that a full examination on the merits of Claims 1-13 be conducted.

Respectfully submitted,

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